

REMARKS

The Examiner rejected claims 1-2, 4-9, 11-20, 25-26, 28 and 30-32 under 35 U.S.C. § 103(a) as being unpatentable over Stein (U.S. Patent No. 5,628,055) in view of Rydbeck, et al. (U.S. Patent No. 5,890,074) and further in view of Bryson (U.S. Publication No. 2004/0185777). The Examiner rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Stein, Rydbeck and Bryson and further in view of Hwang (U.S. Publication No. 2005/0037709). The Examiner rejected claims 10, 21, 27 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Stein, Rydbeck and Bryson and further in view of Shin (U.S. Patent No. 6,006,109). The Examiner rejected claims 22-24 under 35 U.S.C. § 103(a) as being unpatentable over Stein, Rydbeck and Bryson and further in view of Adams, et al. (U.S. Publication No. 2007/0004372). In response, the Applicant has amended certain claims, submitted declarations under 35 U.S.C. § 1.131 by Joseph C. Lee and Richard A. Ryan, and has set forth arguments supporting the patentability of the amended claims over the prior art references. The Applicant believes the amendments made in response to the Examiner's rejections have placed the application in position for allowance.

Rule 131 Declaration

Applicant is submitting the two documents entitled Declaration under 35 U.S.C. § 1.131 to swear behind the Bryson and Hwang references. Although Applicant believes that the claims rejected based on these references (i.e., claims 1-2, 4-9, 11-20, 25-26, 28 and 30-32 11-13 for the Bryson reference and claim 3 for the Hwang reference) are not obvious in light of the

combinations that include the Bryson and Hwang references, Applicant is nonetheless submitting his declaration and that of his attorney showing a date of invention prior to the priority dates of these two references. As such, Applicant believes that these references are inappropriate as a basis for the rejection of the subject claims.

Telephone Conference

The Applicant telephoned the Examiner on January 31, 2007 with regard to his patent application and the current Office Action. During the telephone conference, the Applicant emphasized to the Examiner that his invention is a mobile phone wafer which functions as a stand alone mobile telephone having minimal features (i.e., transceiver, memory, battery, communication device and antenna) for use with a wireless communication network on its own or which can be connected to, either wirelessly or physically (i.e., attached/docked to or inserted within), a peripheral device in order to allow the peripheral device to be directly utilized with the wireless communication network. When the wafer is connected to the peripheral device, the wafer's transceiver unit and memory storage device interface with the peripheral device so that the user can transmit voice or data using the peripheral device. The Applicant was left with the impression that clarifying the above could result in allowance of the claims.

Amendments to the Claims

Applicant has amended claims 1, 14 and 25 to address the Examiner's rejections under 35 U.S.C. § 103(a). Specifically, Applicant is amending these claims as set forth below:

a) claim 1 - Applicant is amending claim 1 to more clearly identify the wafer to peripheral device connection, replace “componentry” with “component” to address the Examiner’s objection thereto, and delete “adaptable” on the same line. In the wherein clause, the Applicant is amending this claim to replace “and” with “or” with reference to the “selectively” term, add the limitation “and said memory storage device” in order to emphasize that both the wafer’s transceiver unit and the memory device are interfaced with the peripheral device, and add the language “over said wireless communication network” at the end of the claim to better emphasize the use of the peripheral device for wireless voice and data communication.

b) claim 3 - Amending claim 3 to replace the language “received on or in” with “docked with or inserted into” to better clarify the relationship between the mobile phone wafer and the peripheral device.

c) claim 14 - Amending this independent claim in the same manner as claim 1 set forth above.

d) claim 25 - Amending this independent claim in the same manner as claims 1 and 14 above.

Applicant’s Invention

As set forth in the specification and claims of Applicant’s, Applicant’s invention provides a new and useful communication device in the form of a mobile phone wafer platform system that enables the user to utilize a mobile phone wafer as a minimalist mobile phone to transmit voice or data communications over a wireless network or to connect the wafer to a

peripheral device to enable the user to utilize the peripheral device for wireless voice and data communication. As set forth in the specification of the present application, Applicant's invention enables a person to purchase a single mobile phone wafer that he or she can utilize on its own as a minimalist mobile phone or which can be utilized with, by connecting wirelessly or physically, a variety of different peripheral devices. Because the wafer connects to peripheral devices, it will not be necessary to provide the peripheral device with the telecommunications capability that is provided on the wafer (which enables the stand alone use). This can save the user a significant amount of money and reduce the problems users typically have with regard to different communication devices. For instance, instead of purchasing a cell phone, laptop and PDA that each have their own separate telecommunications capability, each of the peripheral devices can be provided without this capability and the user can connect the wafer to a particular peripheral device on an as-needed basis. As such, it is anticipated that the cost of the various peripheral devices will be much lower than they are currently. In addition to the lower initial cost, the user will save money as the manufacturers come out with peripheral devices having new and improved features. For instance, when a new cell phone is available that has features desired by the user, he or she would only have to purchase the "shell" cell phone with those new features. The wafer can be utilized with the new phone and the old phone shell can be discarded. Presently, when a person purchases a new cell phone (also true with laptops, PDAs and other devices), the telecommunications electronics that enable connection to a wireless network still function in the same manner but, despite this, they are discarded with the old phone. The Applicant anticipates that this will significantly reduce buyer concern and anxiety with regard to

spending significant sums of money to purchase the newest and latest improvement in technology only to see the expensive device become substantially obsolete in a few months. With the wafer of Applicant's invention, the user keeps the expensive telecommunications component (the wafer) and only has to buy the upgraded shell (i.e., the cell phone having the latest camera and/or video capabilities).

Based on the prior art cited by the Examiner, Applicant desires to make it clear that his invention is not merely attaching a telephone to a printer or other peripheral or inserting a wireless network card, such as a PCMCIA card, into a PDA or other peripheral. These two configurations differ substantially from Applicant's invention and neither configuration solves the problems or provides the benefits of Applicant's invention. Instead, Applicant's invention is a platform system that comprises a mobile phone wafer which can be used as a mobile phone, but otherwise having very few "telephone" features, on its own or connected to the peripheral device so that device can be used to transmit voice or data over the wireless network (in addition to the peripheral's "normal" use). In one embodiment, the peripheral is a cellular phone shell (i.e., all the features except the communications capability - which is provided by the wafer). The user can wirelessly connect or physically insert the wafer into or dock it with the cellular phone shell to use the cellular phone as he or she would normally use a cellular phone. Then the wafer can be removed from the cellular phone and wireless connect or be inserted into or docked with a digital camera, thereby allowing the user to use the camera as he or she normally would and also send voice or data (i.e., photographs) over the wireless network directly from the camera. The wafer can then be removed from the camera and placed in a PDA or printer to allow those

peripheral devices to send/receive voice or data communications. As such, Applicant's invention allows one mobile phone wafer to be utilized with a variety of peripheral devices that are not otherwise provided with communications capability (even the cellular phone shell). This reduces the cost of the peripheral devices and allows the user to less expensively upgrade the peripheral device, such as a new peripheral device with improved cellular phone, camera, PDA or printer features, without having to also replace the communications capability, which is provided by the mobile phone wafer.

Rejection under 35 U.S.C. § 103(a) - General

All of the claims currently pending were rejected under 35 U.S.C. § 103(a) based on obviousness in light of the Stein, Rydbeck and Bryson references and, with regard to certain claims, in combination with other references (as set forth above). With regard to the obviousness rejections, Section 103(a) only denies patentability to those inventions whose "subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." (35 U.S.C. § 103.) Initially, Applicant believes the amendments to the independent claims make these claims allowable, thereby making the dependent claims also allowable. In addition, as stated by the court in In re Geiger, 2 USPQ2d 1276 (CAFC 1987), "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." (In re Geiger, 2 USPQ2d at 1278.) The motivation or suggestion to combine references must exist, otherwise the determination of obviousness involves nothing

more "than indiscriminately combining prior art." (Micro Chemical Inc. v. Great Plains Chemical Co., 41 USPQ2d 1238, 1244 (CAFC 1997).) In In re Fritch, 23 USPQ2d 1780 (CAFC 1992), the Federal Circuit stated the following:

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. (In re Fritch, 23 USPQ2d at 1783-84 (internal quotes and citations removed).)

Claims 1-2, 4-9, 11-20, 25-26, 28 and 30-32

The Examiner rejected claims 1-2, 4-9, 11-20, 25-26, 28 and 30-32 under 35 U.S.C. § 103(a) as being unpatentable over Stein in view of Rydbeck and further in view of Bryson. The Applicant respectfully disagrees with the Examiner. Although Stein discloses a telecommunications module that enables a peripheral device to link to a wireless network for transmission of voice or data over the wireless network, for purpose of enabling connection to different formats and standards, Stein does not disclose, compel, teach or even suggest utilizing

the module as a stand alone mobile phone device. As such, there is no reason for Stein to include a memory storage device to store data or a battery to provide its own electrical power. As discussed in the patent, the module is configured to provide modular telecommunications capability to a peripheral device that contains the data and power necessary to perform the desired functions. In effect, the module of Stein is essentially a PCMCIA card-like module that is suitable for connection to a computer, PDA or cellular phone to provide the modem connection to the wireless network that enables the user to transmit voice or data. Any data utilized by the module to connect to or transmit across the wireless network is obtained from, and only from, the peripheral device. Because the module of Stein is not utilized by itself, it is not necessary to provide it with a battery power. Stein discloses the use of a AC/DC power device or being able to utilize the power of the peripheral device. Functional portability of the module was not an issue in Stein.

The Examiner states that Stein does not explicitly disclose that the mobile terminal wafer communicating with the peripheral device (headset) is a mobile phone and the communication device comprising a short range radio frequency transceiver, but that Rydbeck discloses the mobile terminal wafer is adaptable for connection to a peripheral device and the communication device comprising a short range radio frequency transceiver and, therefore, it would have been obvious to combine this with Stein to allow the mobile phone wafer to connect to a peripheral device in order not to disturb others. The Examiner also states that the host electronic system with which the “mobile terminal wafer” of Rydbeck is utilized is not limited to just portable computers, but can be utilized with other portable devices. Applicant respectfully

disagrees with the Examiner's characterization of the Rydbeck device as a "mobile terminal wafer" in the manner that Applicant utilizes that terminology to characterize his invention. As set forth at the text referenced by the Examiner (i.e., col. 9, lines 37-41), the various modems referenced by Rydbeck, shown as 13, 14, 15, 16 and 17, are directed to modular units suitable for communication over radio networks, the conventional cellular radio network in the United States, European cellular network or other standards of communication. Rydbeck discloses the use of a module that allows wireless communication between a host electronic system, such as a laptop computer, and a headset so that the headset may communicate with a telephone network through the host system. The module is configured to communicate across one or more different standard communication formats. Like the Stein patent, Rydbeck does not disclose, compel or suggest the use of the module as a stand-alone mobile phone wafer that is used for telephone purposes and which can be connected to the peripheral device so that the peripheral device may directly transit voice or data across a wireless communication network.

The Examiner states that Stein and Rydbeck do not disclose that the mobile phone wafer is operatively connected to the peripheral device (headset) to interface the transceiver unit with the peripheral device to allow a user to utilize the peripheral device for wireless voice and data, but that Bryson discloses a connection to interface the transceiver unit with a peripheral device for wireless voice and data. According to the Examiner, it would have been obvious to one skilled in the art to connect to and utilize the peripheral device for voice and data in order to allow the mobile phone to communicate with other devices as suggested by Bryson. Applicant respectfully disagrees with the Examiner's conclusion. Bryson is directed toward a portable

wireless network gateway that aggregates the connectivity demands of a plurality of users having a plurality of user devices which are adapted to communicate via different communication protocols. Bryson notes that many electronic devices are equipped to communicate with other electronic devices and networks based on standards and technologies known in the computer and/or communication arts. The invention of Bryson provides a portable wireless gateway having at least one access point operative to communicate with user devices, a transceiver operative to communicate with a network and a protocol emulator that, as an example, is operative to encapsulate user device data for transmission by the transceiver.

Respectfully, nothing in Stein, Rydbeck and Bryson teaches, suggests or offers any incentive to combine the attributes of these references to result in Applicant's invention. Nothing in these references teaches use of a wafer device which is selectively useful as both a stand-alone mobile telephone for voice/data communication across a wireless communication network and for connection to a peripheral device so that the peripheral device can be directly utilized to transmit voice and data over the wireless communication network. As set forth above, Applicant's invention is a wafer mobile phone platform system that comprises a mobile phone wafer having a transceiver unit, a memory storage device, a battery and a communication device on the wafer so that the wafer can function as a minimalist wireless telephone and be connected to a peripheral device so that the peripheral device can communicate over the wireless network. None of the cited references disclose the use of a wafer or module that is capable of use as both a stand-alone telephone and a device to convert a non-communicating peripheral to a device that communicates over a wireless network. Nothing in Stein, Rydbeck or Bryson suggest providing

a stand-alone telephone wafer or module that is utilized by itself to communicate across a wireless network or connected with a peripheral device so that the peripheral device may then directly communicate across the wireless network. As discussed above and in Applicant's specification, this has significant benefits to the consumer by allowing him or her to purchase a relatively sophisticated mobile phone wafer that is useful as a minimalist phone and which can be connected to (i.e., either wirelessly, wired or being attached to or received into) a peripheral device so the otherwise non-communicating peripheral device may communicate across the wireless network. This allows the user to purchase a sophisticated, but "shell", cellular phone body having all of the latest technology and insert (as one example) the wafer into the shell body so that the cellular phone body is now a full-fledged cellular phone that can communicate across the wireless network. The user can then remove the wafer from the cellular phone body and insert it into or dock it with another peripheral device (such as a digital camera, video camera, PDA or printer) so that he or she may use the other peripheral for voice and data communication over the wireless network. This capability is neither taught nor suggested by the cited prior art, which, respectfully, also does not over any incentive for the combination in the manner suggested by the Examiner.

In light of the foregoing, it is respectfully suggested that claims 1, 14 and 25 are not made obvious by Stein, Rydbeck and Bryson and should be determined to be allowable and the various claims that depend therefrom should also be determined to be allowable. The cited prior art does not disclose the platform system of the present invention being coupled (claim 2) to the peripheral device, being suitable for use with the various peripheral devices of claims 5 and

16, or having an on/off switch, a headphone jack or a display screen (claims 4 and 15). The cited prior art also does not disclose the platform system of the present invention suitable for use with an individual reception device (claims 6 and 17) or a cellular phone having a twelve key keypad and function keys (claims 7, 18 and 26). The cited art does not show the platform system where the communication device is a short range radio (claims 8 and 19) comprising either a Bluetooth or WI-FI module (claims 9, 20 and 28) or adaptable for a wired connection (claims 11, 30 and 32) with a USB, serial, parallel or firewire connection (claims 12 and 31). The cited prior art also does not show the platform system being adaptable to a plurality of peripheral devices to they may be selectively utilized for voice and data communication (claim 13).

Claim 3

The Examiner rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Stein, Rydbeck and Bryson and further in view of Hwang. Initially, as set forth in the Rule 131 declarations, Applicant's date of invention is prior to the priority date of Hwang. In addition, the arguments with regard to the obviousness of claim 1 with regard to Stein, Rydbeck and Bryson, which are incorporated herein, are also applicable to claim 3. Even without swearing behind the Hwang reference, the Applicant respectfully disagrees with the Examiner on the obviousness of claim 3, particularly in light of the believed allowability of claim 1 from which claim 3 depends. Hwang discloses a printing apparatus that includes a printer having a detachable faceplate configured to receive data from a mobile communications device (cellular phone). The cellular phone is docked to the cradle to allow data transmitted via the cellular

phone to be printed by the printer. However, Hwang does not show use of a mobile phone wafer suitable for selective connection to a peripheral device (which may be the cellular phone) or for use as a stand-alone phone as described by claim 1 of Applicant's application, particularly with regard to different types of peripheral devices. The combination of Hwang with the Stein and Rydbeck references, as discussed above, does not teach, suggest or offer any incentive to develop the platform system of Applicant's invention. As such, Applicant believes claim 3 is not obvious in light of the cited prior art.

Claims 10, 21, 27 and 29

The Examiner rejected claims 10, 21, 27 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Stein, Rydbeck, Bryson and further in view of Shin. Initially, Applicant believes the independent claims from which these claims depend are allowable, resulting in these claims also being allowable. In addition, the arguments with regard to the obviousness of claims 1, 14 and 25 with regard to Stein, Rydbeck and Bryson, which are incorporated herein, are also applicable to claims 10, 21, 27 and 29. These claims add the limitation of a headphone jack to the communication device. Applicant believes the attributes of his invention which distinguish it from the prior art, namely a mobile phone wafer that can be used as a stand-alone device or connected to peripherals, also make the addition of a headphone jack thereto non-obvious.

Claims 22-24

The Examiner rejected claims 22-24 under 35 U.S.C. § 103(a) as being unpatentable over Stein, Rydbeck, Bryson and further in view of Adams. Initially, Applicant believes the independent claims from which these claims depend are allowable, resulting in these claims also being allowable. In addition, the arguments with regard to the obviousness of claim 14 with regard to Stein, Rydbeck and Bryson, which are incorporated herein, are also applicable to claims 22-24. As set forth above, Applicant respectfully takes the position that Stein, Rydbeck and Bryson do not disclose or make obvious Applicant's invention, whether with a wireless or a wired connection between the wafer and the peripheral device. As such, Applicant does not believe that the wired connection in Adams (paragraph 40) makes his invention obvious.

In light of the above amendments and arguments, Applicant respectfully requests the Examiner to withdraw the rejection of the claims, as amended, in the subject patent application.

Applicant's original application included fees for three independent claims and a total of thirty-two claims. No claims are being added and none are being deleted, therefore, after this amendment a total of thirty-two claims, including three independent claims, are pending in this application. No additional fees for claims are believed due.

In view of the foregoing, it is submitted that this application is in condition for allowance. Reconsideration of the rejections in light of this Amendment is requested. Applicant

believes that the amended claims are in condition for allowance. Allowance of claims 1-32 is respectfully solicited.

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Respectfully Submitted,

By _____

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